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Docket No. F-8290

Ser. No. 10/501,654

REMARKS

Claims 1-15 remain pending in this application. Claims 2, 3, 5, and 9 are allowed. Claims 1, 4, 6-8, and 10-15 are rejected. Claims 1, 4, 6-8, and 10-14 are amended herein to place them in better form. Applicants respectfully request that the present amendment be entered since the claims are merely being placed in better form and no change of scope is being effectuated.

Claims 10 and 11 have been rejected under 35 U.S.C. § 112, first paragraph, as containing new matter. The Office Action states that the original disclosure does not explicitly state that the torsion bar is made from steel material of a solid, non-hollow shape in the longitudinal direction. Applicants respectfully point out that there is no requirement that claims have explicit support in the specification. The Federal Circuit has stated that the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter at issue. *See Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). Figure 3 of the present application discloses measurements of hardness being taken at different distances from the center axis of the steel material, including the center. If the torsion bar had a longitudinal cavity, it would not be possible to measure the hardness at various points, especially at the intersection of the central lines shown in Figure 3. Thus, it would be clear to one of ordinary skill in the art that the present application has ample support for a claim reciting a steel object not being

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hollow in a longitudinal direction, as recited in claims 10 and 11. Accordingly, it is respectfully requested that the rejection of claims 10 and 11 as containing new matter be withdrawn.

Claims 14 and 15 have been rejected under 35 U.S.C. § 112, second paragraph, as indefinite since they refer to the torsion bar of claim 1 and the torsion bar of claim 7. The Office Action states that claims 1 and 7 are not directed to a torsion bar and that therefore the recitation of claims 14 and 15 directed to a torsion bar is indefinite. Claim 7 is directed to a torsion bar since it recites "[a] torsion bar having . . .". Thus, it is Applicants' position that claim 15 is definite and notice to that effect is respectfully requested.

Regarding claim 14, the form of the claim has been amended to refer to "the torsion bar manufactured by the manufacturing method according to claim 1." It is Applicants' position that claim 14 is now definite and notice to that effect is respectfully requested.

Claims 1, 4, 6, 7, 12, and 13 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,741,833 (Beringer).

The Examiner states that the recitation of hardening of the "entire steel material" does not necessarily mean that the entire length of the steel material is being put through the die and hardened. The Examiner says that the "entire steel material" could be interpreted to mean, *inter alia*, an entire section of the steel material. Applicants disagree with the Examiner's interpretation and

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assert that a reference to "entire steel material" means the entire material.

Nevertheless, Applicants have placed claims 1 and 7 in better form to address the Examiner's concerns.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. Claims 1 and 7 recite that the entire longitudinal length of the steel object is put through the die and hardened. In contrast, Beringer recites, in column 1, lines 36-40, that a step in the invention of Beringer is "the step of applying a deformative pressure to a section of the tube by a tool" (emphasis added). Also, Figure 3 in Beringer, for example, shows that the entire tube is not put through the die. Thus, Beringer fails to disclose the entire longitudinal length of the steel object being hardened, as recited in claims 1 and 7. Accordingly, for the above mentioned reasons, claims 1 and 7 are patentable over Beringer and notice to that effect is respectfully requested. Claims 4 and 6 are patentable at least for the reason that they depend from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

Regarding claims 12 and 13, the Office Action rejected the claims and did not address the recitation of the diameter of the steel material being uniform. It is Applicants' position that the language of "said steel material has a uniform

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diameter" communicates to one of ordinary skill in the art that it is the diameter of the entire material. However, in the event that the Examiner prefers a stylistically different way of wording the claims, claims 12 and 13 have been amended and placed in better form. Claims 12 and 13 now recite the uniform diameter being along an entire longitudinal length of the steel object. Claims 12 and 13 are patentable over Beringer at least because they depend from patentable base claims and because Beringer fails to disclose the entire longitudinal length of steel object having a uniform diameter, as recited in claims 12 and 13.

Claims 7, 8, 14, and 15 have been rejected as anticipated under GB 2,240,059 (Imura). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131. As stated above, claim 7 recites that the entire longitudinal length of the steel object is put through the die and hardened. Furthermore, claim 8 recites a range of hardness for the entire longitudinal length of the steel object. In contrast, the entire length of the object disclosed in Imura is not put through a die and hardened and the entire length of the object disclosed in Imura does not have the hardness recited in claim 8. In Imura et al., the cold drawing is only performed on certain longitudinal portions of the bar, as shown in Figs. 2A - 2E of Imura et al. Thus, not all of the length of the torsion bar of Imura et al. is hardened

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and, therefore, the structure of the torsion bar in Imura et al. is different than the structure as claimed in claim 7 of the current application, where the entire length is hardened. In fact, on page 6, third full paragraph of Imura et al. it is stated that "the Vickers hardness test was also performed on a surface P7 of a not-swaged portion, and on a center P8 of a diameter of the not-swaged portion." Thus, portions P7 and P8 were not hardened, as specifically stated in Imura et al. In other words, not all of the length of the torsion bar of Imura et al. was hardened. Accordingly, claim 7 is patentable over Imura et al. and notice to that effect is respectfully requested.

Claim 8 is patentable at least for the reason that it depends from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974). Furthermore, Imura et al. fails to disclose that the hardness of the entire longitudinal length of the steel object after cold drawing work has a Vickers hardness ranging from 320 to 450, as recited in claim 8. For example, portions P5, P6, P7, and P8, as shown in Table 1 of Imura et al., have a hardness that does not fall within the recitation of claim 8. Thus, claims 7 and 8 are patentable over Imura et al. and notice to that effect is respectfully requested.

The Office Action states on page 4 that "[a]s to the applicability of Imura against claims 7 and 8, this is considered tenable. Applicant argues that the entire bar is not hardened. This is not so." As stated above, on page 6, third full paragraph of Imura et al. it is stated that "the Vickers hardness test

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was also performed on a surface P7 of a not-swaged portion, and on a center P8 of a diameter of the not-swaged portion" (emphasis added). It is clear that portions P7 and P8 are not-swaged, which means that they have not been hardened. Thus, it is clear that Imura et al. does not disclose hardening the entire length of the bar. Furthermore, as stated above, the cold drawing disclosed in Imura et al. is only performed on certain longitudinal portions of the bar, as shown in Figs. 2A - 2E. The description describing Figs. 2A-2E makes this clear. For example, in step 2B, as described on the third full paragraph of page 4 of Imura et al., it is stated that the round-bar steel "is inserted into the swaging machine such that the first position X1 is aligned with the dies." Thus, it is clear that, for example, the portion between X1 and 3a in Figure 2B is not being swaged. Accordingly, claims 7 and 8 are patentable over Imura et al. and notice to that effect is respectfully requested.

Claims 14 and 15 are patentable over Imura et al. at least for the reason that they depend from a patentable base claim. Claims 14 and 15 are further patentable over Imura et al. because Imura et al. fails to disclose the recitations of claims 14 and 15. The Office Action states that since the torsion bar disclosed in Imura et al. is for power steering devices, that it is evident that the torsion bar is connected between the power steering box and the steering mechanism for the vehicle. The Office Action provides no evidentiary support for this statement and therefore anticipation of claims 14 and 15 has not been

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demonstrated. Accordingly, Applicants respectfully request that the patentability of claims 14 and 15 be acknowledged.

Applicant respectfully requests a two month extension of time for responding to the Office Action. The fee of \$450.00 for the extension is provided for in the charge authorization presented in the PTO Form 2038, Credit Card Payment form, provided herewith.

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

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In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

By and,

By Ricardo Unikel
Ricardo Unikel
Reg. No. 52,309
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

cnc: Form PTO-2038